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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,932	10/30/2003	James F. McGuckin JR.	1255	1044
7590 NEIL D. GERSHON REX MEDICAL 1011 HIGH RIDGE RD Stamford, CT 06905				
EXAMINER SHAFFER, RICHARD R				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
11/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,932

Applicant(s)

MCGUCKIN ET AL.

Examiner

Richard Shaffer

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11, 13-18 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11, 13-18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The previous Final Office Action mailed on September 30th, 2008 is vacated. A Non-Final Office Action resetting the time period for reply is as follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

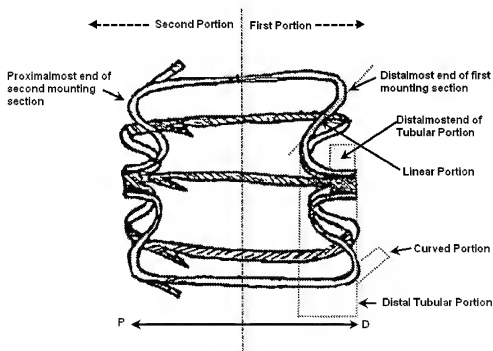
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7, 9, 11, 13, 14, 16, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma et al (US Patent 6,443,972) in view of Van der Burg et al (US Patent 6,994,092).

Bosma et al disclose a vessel filter (**Figures 5 and 8-9C**) and method (**Figure 1**) comprising: a mounting section (middle section) having a proximal and distal end; two filtering sections (angled portions converging at tubular sections); the filtering sections defined by a plurality of longitudinal struts with ribs connecting adjacent struts; the device is self-expanding Nitinol (**Column 4, Lines 11-15**); the struts are spaced circumferentially about 60 degrees apart; a plurality of vessel engaging members (**27**) and/or roughening (**Column 6, Lines 52-53**); and the struts (in **Figure 8**) have an angled portion with a width less than the width of the straight portion of the mounting section.

Bosma et al disclose all of the claimed limitations except for the specific structure and location of the filtering section with regard to the mounting section. Van der Burg et

al teach (**Figure 35; Column 18, Lines 34-55**) that an expandable device for placement against a bodily tubular structure with an S-shape end portion provides an elongated mounting section which improves contact area. It would have been obvious to one having ordinary skill in the art at the time of invention to design the filter of Bosma et al according to the structure taught in Van der Burg et al in order to improve fixation within the blood vessel. In regard to applicant's extensive claim language defining the relationship between the filter section and mounting section, see the Figure below depicting how the structure of Van der Burg et al meets the claimed limitations.



Claims 8, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma in view of Van der Burg et al and in further view of Gilson et al (US Patent Application Publication 2002/0058911).

The combination of Bosma and Van der Burg et al disclose and teach all of the claimed limitations except for struts out of phase. Gilson et al teach in **Figures 15-22** out of phase struts as an appropriate structure for forming an expandable structure to act as an embolic filter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combination of Bosma and Van der Burg et al with out of phase struts as a matter of mere substitution for providing an expandable embolic filter with predictable results.

Response to Arguments

Applicant's arguments filed June 16th, 2008 have been fully considered but they are not persuasive.

Applicant states that Van der Burg et al lack a distalmost end point of a distal tubular portion proximal of distalmost end points of struts of the mounting section. As shown in the figure in the previous page, at least the two bottom struts on the right are shown distal of the distalmost point of the tubular section as well as the two back struts on the left side being proximal of the proximalmost point of the tubular section.

The examiner would also like to note that in regard to claim 21, due to the claimed invention being directed to a state of the device, the combination of Bosma et al and Van der Burg et al is inherently capable of additional movement of the tubular portions into the center of the device.

Applicant additionally contends that Van der Burg et al lack linear portions of the mounting sections extending axially and radially inward. Again, as previously shown, there are portions that depict a linear strut member.

Applicant also states that Van der Burg et al lack the proximalmost and distalmost end points of the tubular portions axially aligned with a region of the linear portion. As already described in this remarks, there are portions further from the center of the device including a portion of the linear portion therefore axially aligning the distalmost/proximal most tubular end points with the linear portions of the struts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Shaffer whose telephone number is (571)272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard Shaffer/
Examiner, Art Unit 3775
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733